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IN THE

Supreme Court of the United States

OCTOBER TERM, 1941.

No. 737

WALGREEN CO., AND ALLIED ELECTRIC PRODUCTS, INC.,

Petitioners,

vs.

GEORGE H. GLADE, JR.,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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Chicago, November 22, 1941.

THE GUNTHORP-WARREN PRINTING COMPANY, 310 WEST JACKSON, CHICAGO

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To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:

INTRODUCTORY STATEMENT.

This case, in the United States Circuit Court of Appeals for the Seventh Circuit, involved the usual issues of validity and infringement of Martin Patent 2,115,642 relating to Electrical Conductor Terminal Caps. The Court of Appeals (R. 674) held the patent valid and infringed, affirming the judgment of the District Court (R. 286) and subsequently denied a Petition for Rehearing (R. 683).

No conflict of decisions in different Circuit Court of Appeals is involved.

A brief chronological history of the invention and of its appropriation by Petitioner is as follows:

Martin, the inventor, while in the employ of Glade Manufacturing Company of Chicago, a partnership, assigned his invention to George H. Glade, Jr., one of the two partners, the other being his father, George H. Glade. The company caused a patent application to be filed August 5, 1929 and conducted the prosecution of it.

In 1931 the invention was put on the market by Glade Manufacturing Company (R. 88). In March 1933 an interference was declared by the Patent Office with an application of Benander whose assignee was General Electric Co. (R. 250). During 1934, Respondent, Glade, and his father had been buying certain products from Petitioner, Allied Electric Company of Irvington, New Jersey. In 1935 Glade, Sr. showed the Martin plug to the president of Allied Electric Company, the Petitioner (R. 74, 75). Later in the same year the Allied Company began the sale of the infringing plugs complained of.

On February 4, 1937 the Board of Appeals in the Patent Office awarded priority of invention to Martin in said interference, and against the General Electric Company. Said company shortly thereafter took a license under said application (R. 72, 83). Other companies took lisences subsequently (R. 72). In September 1937, Petitioner advertised that it had sold many million of the rival plugs. The Martin patent had not yet been granted at that date, due to the final steps taken in the prosecution of the application and necessitated by the excessively long priority contest in the Patent Office. Before the issuance of the Martin patent, the Respondent, of course, had no redress for the competition caused by the sale of millions of substantially identical rival devices. However, said Martin patent finally issued April 26, 1938 to Glade, Jr., the Respondent, after having been in the Patent Office almost nine years.

The Glades, after trying to dissuade Allied Company

from continuing its infringement (R. 75) filed suit in October 1939 against a customer of Allied in Chicago, *i. e.*, Walgreen Company. About a month prior thereto, September 27, 1939, following the Respondent's attempts to dissuade Allied Company from infringing, the latter bought an earlier patent than the Martin patent, *i. e.*, McCormick 1,961,235, under which it sought to justify its infringement. This patent was made the basis of a counterclaim but the claims thereof were held invalid both by the District Court and the Court of Appeals, and no review is sought by Petitioners of the judgment of the court below in invalidating said McCormick patent, as explained at the bottom of page 3 of the Petition.

SUMMARY OF ARGUMENT.

Reference may be had to the index for this summary.

POINTS AND AUTHORITIES.

These are incorporated in the argument and hence, in the interests of brevity, are not duplicated here.

ARGUMENT.

I.

The action below involved the usual issues of validity and infringement in a patent case, there being no conflict of decisions in different Circuit Courts of Appeals.

The Martin Patent 2,115,642, owned by the Plaintiff Glade, the Respondent, was involved for four years in the priority contest or interference in the Patent Office with a Benander application owned by the General Electric Company before it issued as a patent. The only unusual feature of this case is, therefore, that the patent in suit was subjected to an exceptionally close scrutiny by the Patent Office and by the opposing party before said patent was granted.

In the District Court of Northern Illinois, Eastern Division, Judge John P. Barnes, after a full hearing lasting several days, held all of the claims in suit valid and infringed (R. 286-289, inclusive).

Subsequently the Court of Appeals for the Seventh Circuit (Judges Evans, Sparks and Kerner) affirmed the decision of the District Court in an exhaustive and unanimous opinion (R. 674-682, inclusive), in which substantially all the points now presented in the Petition for Writ of Certiorari were ruled on adversely, having been presented also to the Court of Appeals in a Petition for Rehearing.

It has long been the established practice of this Court to refuse to review issues as to invention and the validity of a patent under these circumstances.

Thus, in the case of *Continental Paper Bag Company* v. *Eastern Paper Bag Company*, 210 U. S. 405 (52 L. Ed.

1122, 1127), this Court, in an analogous situation, said at page 416:

> "The lower courts, therefore, found that the invention was a broad one, and that the machine used by the Continental Company was an infringement. And these were questions of fact upon which, both of the courts concurring, their findings will not be disturbed, unless clearly wrong. *Deslions* v. *La Compagnie Generale Transatlantique,* 210 U. S. 95, *ante,* 973, 38 Sup. Ct. Rep. 664."

Similarly, in the more recent case of *General Talking Pictures Corporation* v. *Western Electric Company, Inc., et al.,* 304 U. S. 175 (82 L. Ed. 1273, 1275) this Court said, at pages 178, 179:

> "There is nothing in the lower courts' decision on either of the added questions to warrant review here. Whether respondents acquiesced in the infringement and are estopped depends upon the facts. Granting of the writ would not be warranted merely to review the evidence or inferences drawn from it. * * * Moreover, the decision on that point rests on concurrent findings. *They are not to be disturbed unless plainly without support.* * * * *There is evidence to support them. Nor would the writ be granted to review the questions of anticipation and invention that petitioner argues,* for as to them there is no conflict between decisions of circuit courts of appeals."

There is no conflict between or among Circuit Courts of Appeals as to the validity or infringement of the Martin patent in suit, since the litigation below was the first and is the only adjudication of this patent.

Under such circumstances it has long been the established policy of this Court to refuse to grant the writ of certiorari prayed for here. (Judicial Code, as amended, Sec. 240a, U. S. C. A. Title 28, Sec. 347, Rule 38 of the Rules of the United States Supreme Court, Par. 5, Secs. a, b and c.)

Thus, in the case of *Caroline M. Forsythe* v. *City of Hammond, et al.*, 166 U. S. 506 (41 L. Ed. 1095, 1098, 1099), this Court in reiterating a policy with respect to granting certiorari, even then long established, said, at pages 514 and 515:

> "* * * it is a power which will be sparingly exercised, and only when the circumstances of the case satisfy us that the importance of the question involved, the necessity of avoiding conflict between two or more courts of appeals, or between courts of appeal and the courts of a state, or some matter affecting the interests of this nation in its internal or external relations, demands such exercise."

Similarly, in a later case, namely, *Clarence D. Keller et al.* v. *Adams-Campbell Company, Inc., et al.*, 264 U. S. 314, 68 L. Ed. 705 (1924), this Court, in an analogous patent case, said, at page 319:

> "Such an ordinary patent case with the usual issues of invention, breadth of claims and non-infringement, this court will not bring here by certiorari unless it be necessary to reconcile decisions of circuit courts of appeal on the same patent."

II.

REPLY TO POINT 1 OF PETITIONER'S BRIEF.

This first ground (see p. 13 of Petitioner's brief) is based on the assertion that Petitioner was heretofore the largest manufacturer of a certain type of electric attachment plugs in the United States and that since the issuance of the injunction against Petitioner for infringement of Respondent's patent, the users of such plugs have been deprived of substantially one-third of their previous supply, resulting in an acute shortage, which is alleged to be detrimental to the industry as a whole and hence a matter of national concern. The Petitioner is unable to point to any part of the voluminous record, however, to establish

this allegation. The record does show that Respondent and Glade Manufacturing Company completed the commercial development of the attachment plug in issue and has had it on the market continuously ever since (R. 88 and Plaintiff's Exhibit 9). This attachment plug was disclosed to the president of the defendant company, Allied Electric Products, Inc. (the Petitioner), long before the patent issued (R. 75) and was copied in its essential features by the Petitioner and marketed in competition with Respondent's plug.

It is a matter of common knowledge that the recent defense program has greatly restricted the output of many manufacturers of non-essential products due to the enormous demand for certain metals, particularly copper and brass, resulting in priority rulings thereon. The attachment plug in issue consists of brass prongs held in a base of insulating material, as described more in detail on page 2 of the Petition. The lack of brass is primarily responsible for the difficulty now complained of by Petitioner, which shortage affects the Respondent as well.

A reversal of the decree of the Seventh Circuit Court of Appeals under which Petitioner would be permitted to resume manufacture of respondent's plug, would not free the Petitioner from priority restrictions and said Petitioner would be no more in a position to relieve the acute shortage of plugs than any other manufacturer needing large quantities of brass for electrical products. Such manufacture could have been continued, however, had Petitioner filed the requisite bond prior to the filing of its appeal (R. 304).

III.

REPLY TO POINT 2 OF PETITIONER'S BRIEF.

The allegation on page 14 of Petitioner's brief is, in substance, that the Court of Appeals read into claim 5 a limitation without which the claim would not distinguish from the prior art even in words, must less in substance, and that the court erred in so doing.

Claim 5 was one of the claims involved in the long priority contest in the Patent Office, and was awarded to Martin after a careful consideration of the prior art and against the opposition of General Electric Company, the award having been made first by the Examiner of Interferences and subsequently on appeal by the Board of Appeals (R. 216). An earlier decision of the Board of Appeals approved this claim as to patentability, before the priority issue was presented (Exhibit 23, R. 163).

When Petitioner, in its brief before the Seventh Circuit Court of Appeals made this same assertion with respect to the invalidity of claim 5, the Respondent pointed out in his brief that said claim 5 (printed at the bottom of page 14 of the Petition) distinguished from the prior art and particularly from the British Day Patent 14,306 of 1912 in stating that—

> "the sides of the prongs having laterally extending projections which *engage* the *walls* of the *holes* and resist removal."

The Court of Appeals recognized these distinctions between said claim and the prior Day patent, in the last two lines of its opinion, as found at the bottom of page 5 thereof (R. 678) stating also as to these two patents—

> "They not only differ as to details but also as to concepts."

It is true, as stated in substance by Petitioner, that the opinion, on page 8 thereof, states:

> "We think claim 5 does contemplate a central bore

> in the plug body because it is ever present in the device described in the specification."

Nevertheless, it will be noted that the court had previously stated in substance that this claim was patentable over the prior art, and hence the subsequent discussion on page 8 (R. 681) relates to what may be called matters of form. The conclusion we draw is that it is immaterial whether claim 5 should include express reference to the central bore or not, as a central bore *per se* is shown in most of the references relied on by the Defendant, the Petitioner.

It is unnecessary, therefore, to discuss the Supreme Court cases which the Petitioner relies on as disapproving of reading into a claim "an element which it does not contain." As previously stated, the claim is clearly valid without any added element, if in fact an opening can properly be said to be an "element" in the sense of something tangible.

IV.

REPLY TO POINT 3 OF PETITIONER'S BRIEF.

This heading identifies a discussion as to simplification from a five part to a three part plug.

Petitioner has overstated the case in asserting on page 16—

> "As the major and *only* basis expressed in the Court's opinion for finding patentable subject matter in the Martin plug, the Court below said:" (Emphasis ours.)
>
> > "'In other words, he produces the same result in a more efficient and facile manner by making *three* of those old elements accomplish the same result as *five* or more had theretofore done.'"

This remarkable accomplishment in a crowded art is not the *only* basis for finding patentable subject matter in the Martin plug. The Court also compared the claims carefully with the prior art to determine whether said claims

were anticipated and having concluded that they were *not anticipated,* the Court then considered whether the structure of these claims involved invention as distinguished from mechanical skill. The Court ruled in substance that the Defendant had failed to overcome, by the prior art patents relied on, the burden of showing clearly that the same invention was disclosed in said patents. This conclusion obviously is the "major" basis of the opinion, *i. e.,* that the Martin claims in issue do *not* read on the prior art, and hence are not anticipated.

In substantiation of our statements we quote from the opinion, the first paragraph on page 4, in which the position taken by the defendants is concisely stated by the Court as follows:

> "Defendants first contend that the general combination, which Martin claims, was old in the art;"
> (second) "that he disclosed no new result or new coaction of the elements, and hence there was no invention in substituting any particular elements in that old combination."

The Court then stated that the defendants were in error—

> "In this we think defendants are in error, and we think the error in this respect lies in the assumption that the general combination of Martin was old in the art, and that there was no new coaction of the elements used."

No legitimate conflict can be found in this decision in the Seventh Circuit Court of Appeals, as contrasted with opinions of the Supreme Court in the cases cited near the top of page 18 of Petitioner's brief.

V.

REPLY TO POINT 4 OF PETITIONER'S BRIEF.

Petitioner's fourth point, on page 18 of its brief, alleges that the Martin claims are unpatentable aggregations, whereby the Court of Appeals' decision is in conflict with Supreme Court cases such as *Lincoln Engineering Co.* v. *Stewart-Warner Corp.*, 303 U. S. 545, 549.

This identical allegation was before the Seventh Circuit Court of Appeals and was disposed of on page 5 of its opinion (R. 678) as follows:

> "In support of their contention, the defendants rely on *Lincoln Engineering Co.* v. *Stewart-Warner Corp.*, 303 U. S. 545. That case held that the mere aggregation of a number of old elements which in the aggregation, perform no new or different function or operation than that theretofore performed or produced by them, is not patentable invention. Obviously, that patent contained all of the elements of a prior art device, while in the Martin patent there are two or more elements in every prior art case cited which are not present in Martin, and the limited number of elements in his combination do coact in an inventively new manner."

Conclusion.

The alleged errors relied on by Petitioner have been analyzed herein to show that there is no real basis therefor in the opinion of the Court of Appeals. Furthermore, even if errors of fact did appear in said opinion, it would afford no ground for the grant of a writ of certiorari by the Supreme Court in the absence of a definite conflict of decisions.

The Martin patent in suit below, and its validity, are matters of purely private interest rather than of public interest or importance, within the meaning of those terms

as employed in decisions construing or applicable to Rule 38 of the rules of this Court.

It is submitted, therefore, that the Petition should be denied.

Respectfully submitted,

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Chicago, November 22, 1941.